

DOCKET NO.: MSFT-0561 (144166.1)
Application No.: 09/717,588
Office Action Dated: June 17, 2004

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

Reconsideration of this application in view of the above amendments and following remarks is requested. After entry of this amendment, claims 1-13, 16-17, 19-21 and 23-35 (a total of 31 claims) are pending in the application. Claims 13, 16, 19, 20, 21, 24, 34 and 35 are amended and claims 18 and 22 are canceled (claims 14-15 were previously canceled).

In the final office action dated June 17, 2004, the examiner objects to the drawings under 37 CFR § 1.83(a) for failing to show every feature of the invention specified in the claims. The examiner also objects to the specification under 35 CFR § 132 because the amendment filed December 19, 2003 introduces new matter into the disclosure.

The examiner rejects claims 1-12, 17, 20, and 25-33 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claims 18, 34 and 35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13 and 18-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ferrara, The KIM Query System – An Iconic Interface for the Unified Access to Distributed Multimedia Databases (“Ferrara”). Lastly, claims 16 and 20-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,950,190 (“Yeager”), in view of Ferrara.

Drawings

The examiner objects to the drawings under 37 CFR § 1.83(a) for failing to show every feature of the invention specified in the claims, namely, requiring that the query-definition fields of claim 21, and the first input region and the second input region of claim 1, be shown in the drawings or canceled from the claims.

Applicant contends that the query-definition fields of claim 21 and the first and second input regions of claim 1 are represented in the drawings. Regarding the first and second input regions of claim 1, the drawings include input region elements including 402, 404, 406, 502, 504, 506, 702, 704, and 706. Regarding the query-definition fields of claim 21, the drawings include query input fields including 402(a-d), 404(a-c), 406(a-b), 502(a-d), 504(not delineated), 506(a-d), and analogous fields in regions 702, 704, and 706, as stated at page 12, lines 13-14.

Specification

The examiner objects to the specification under 35 CFR § 132, stating that the amendment filed December 19, 2003 introduces new matter into the disclosure. The examiner cites 35 CFR § 132, which states that no amendment shall introduce new matter into the disclosure of the invention. The examiner states that the added material not supported by the original disclosure exists in the substitute specification at page 3, line 19, through page 6, line 5.

Applicant respectfully traverses the examiner's objection, and submits that the material of page 3, line 19, through page 6, line 5, added to the specification by the amendment filed December 19, 2003, does not add new matter to the disclosure. The material added to the specification, at page 3, line 19, through page 6, line 5, by the amendment filed December 19, 2003, is the language of originally filed claims 1-12, 17, 20, and 25-32. The addition to the specification of originally filed claim language is not the addition of new subject matter. MPEP § 608.01(l) and § 608.04.

MPEP § 608.04 states that in establishing disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies

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it, and cites MPEP § 608.01(l) for this statement. MPEP § 608.01(l) further provides that where subject matter not shown in the drawing or described in the specification is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

Accordingly, applicant submits that the specification amendments at page 3, line 19, through page 6, line 5, included in applicant's amendment filed December 19, 2003, are proper and are in accordance with the practice and procedure articulated in MPEP § 608.01(l), in that applicant has amended the description to show the subject matter of the originally filed claims, as MPEP § 608.01(l) requires. Applicant, therefore, respectfully requests that the examiner withdraw the specification objection.

Claim Rejections – 35 USC § 112, 1st Paragraph

The examiner rejects claims 1-12, 17, 20, and 25-33 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The examiner characterizes these claims as containing subject matter not described to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time of application filing.

Applicant respectfully traverses the rejection of claims 1-12, 17, 20, and 25-33 under 35 U.S.C. § 112, first paragraph. Applicant has satisfied the written description requirement, through inclusion of the subject matter at issue in originally filed claims, thereby adequately

conveying to one skilled in the art that the inventor had possession of the claimed invention at the time of application filing.

For example, in *In re Smith*, 481 F.2d 910 (C.C.P.A. 1971), the CCPA addressed the written description requirement and held that "where the claim is an original claim, the underlying concept of insuring disclosure as of the filing date is satisfied, and the description requirement has likewise been held to be satisfied." *Id.*, at 914. Accordingly, in the case of original claims, the written description requirement is satisfied because the underlying concept of disclosure as of the filing date is satisfied. This, therefore, necessarily and reasonably conveys to one skilled in the art that the inventor had possession of the claimed invention at the time of application filing.

In *In re Gardner*, 475 F.2d 1389 (C.C.P.A. 1973), the CCPA reversed a 35 U.S.C. § 112 written description rejection and held that the written description requirement was satisfied for an original claim, finding that the original claim in and of itself constituted a description in the original disclosure equivalent in scope and identical in language to the total subject matter being claimed. The CCPA found that nothing more was necessary for compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112.

Further, in *In re Wertheim*, 541 F.2d 257 (C.C.P.A. 1976), the CCPA stated that the written description requirement functioned to ensure possession of the invention by the inventor as of the filing date. The court held, in *Wertheim*, that original claim 4 served and satisfied its own written description requirement.

Accordingly, original claims fulfill the written description requirement as they constitute part of the original disclosure. Applicant, therefore, respectfully requests that the

examiner withdraw the claim rejections under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Claim Rejections – 35 USC § 112, 2nd Paragraph

The examiner rejects claims 18, 34 and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, due to vague limitations. More particularly, the examiner states that claim 18 does not provide clear distinction between the preamble and the body of the claim; that the limitation “adapting at least a portion of the user interface” is vague in claim 34; and that the limitation “adapted to the query definition” is vague in claim 35.

Applicant has canceled claim 18 for reasons unrelated to patentability. Although applicant does not necessarily agree that the above quoted language in claims 34 and 35 is vague to those skilled in the art, claims 34 and 35 have been amended to employ alternative, equivalent language.

Claim Rejections – 35 USC § 102(b)

The examiner rejects claims 13 and 18-19 under 35 U.S.C. § 102(b) as being anticipated by Ferrara, The KIM Query System – An Iconic Interface for the Unified Access to Distributed Multimedia Databases (“Ferrara”). Regarding claim 13, the examiner refers to the abstract, Figures 1-3, and pages 30-31 and 35 to support that Ferrara teaches “receiving information regarding one or more query properties from one or more of the search providers,” and “communicating a query based on one or more of the received query properties....” Regarding claims 18-19, the examiner refers to the Figures 1-3 and page 35 to support that Ferrara teaches “obtaining information regarding query definition forms...”

Applicant respectfully traverses the examiner's rejection of claims 13 and 18-19 under 35 U.S.C. § 102(b). A claim is anticipated under 35 USC § 102(b) only if each and every element set forth in the claim is disclosed (i.e., identically described) in a single prior art reference. Ferrara does not disclose each and every element of claims 13 and 18-19 of the present invention. For instance, Ferrara does not disclose, teach or suggest, among other things, receiving information regarding one or more query properties from one or more of the search providers. Ferrara also does not teach obtaining information regarding query definition forms of the search providers. In fact, Ferrara does not teach the reception of any information from the one or more search providers. Further, Ferrara does not disclose, teach or suggest the communicating of a query, using a user interface configured based on one or more of the received query properties, to one or more of the search providers.

Rather, Ferrara teaches an application interface including a homogenous (common) language that is an extension of the existing SQL language, improved by operation through conceptual models, not physical implementations. Accordingly, Ferrara teaches an information manager purporting a capability to accept requests in this common language and to translate this common language request into the specific language of the involved database. Ferrara, however, does not disclose, teach, or suggest the reception of information from the one or more search providers, or the obtaining of query information of the search providers. Accordingly, Ferrara also does not then teach communicating a query based upon the information received from the one or more search providers, defining a user interface based on the search provider information obtained, or communicating a query, using a user interface configured based on one or more of the received query properties, to one or more of the search providers.

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Applicant, therefore, respectfully requests that the examiner withdraw the rejection of claims 13 and 19 under 35 U.S.C. § 102(b). For reasons unrelated to patentability, applicant has canceled claim 18.

Claim Rejections – 35 USC § 103

The examiner rejects claims 16 and 20-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,950,190 (“Yeager”) in view of Ferrara. The examiner believes that it would be obvious to combine the references of Yeager and Ferrara because Ferrara shows how the compatible dynamic interface of Yeager would be able to distribute the data to more than one provider.

Applicant respectfully traverses the examiner’s rejection of claims 16 and 20-24 under 35 U.S.C. §103(a), as applicant denies that a *prima facie* case of obviousness has been established. Applicant contends that the examiner’s rejection fails to address all of the features of the rejected claims, and is conclusory, without adequate justification existing in Yeager, in view of Ferrara, to substantiate a §103 rejection. Neither Yeager nor Ferrara disclose, teach or suggest, whether alone or in combination, the recitations of claims 16 and 20-24.

Regarding claim 16, the examiner’s basis for rejection fails to address the recitation of transforming the parse tree representation of the query from the first one of the search providers, based on query properties received from and regarding the second one of the search providers. Neither Ferrara nor Yeager disclose, teach or suggest obtaining query properties of the search providers, as received from the search providers, this fact thereby precluding a teaching or suggestion in either Ferrara or Yeager to use obtained query property information of a search provider as a basis for transforming a query representation.

When evaluating a claim for obviousness, all limitations of the claim must be evaluated. The examiner cannot ignore a material, claimed limitation that is absent from the reference(s). Similarly, regarding claim 20, the examiner's basis for rejection fails to address the recitation of communicating information regarding query definition forms from the search providers to the graphical user interface providing that the graphical user interface be configured to the query definition forms communicated from one or more of the search providers. Again, neither Ferrara nor Yeager disclose, teach or suggest this recitation.

Finally, regarding claim 21, the examiner's basis for rejection fails to address the recitation of identifying query operators and query-definition fields supported by each search provider by receiving information from each search provider identifying its unique query operators and query definition fields. Again, neither Ferrara nor Yeager, either alone or in combination, disclose, teach or suggest this feature, or the use of this information as a basis allowing definition of a query within a displayed user interface.

Accordingly, applicant requests that the examiner withdraw the rejection of claims 16 and 20, 21 and 23-24 under 35 U.S.C. § 103(a). Applicant has canceled claim 21.

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CONCLUSION

In light of the above amendments and remarks, applicant submits that pending claims 1-13, 16-17, 19-21 and 23-35 (a total of 31 claims) are in condition for allowance and respectfully requests that the examiner issue an early notice of allowance.

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